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**REMARKS**

This case has been carefully reviewed and analyzed, and reconsideration and favorable action is respectfully requested.

The present invention is directed to a novel hand exerciser that comprises a loop and a plurality of rings each having a hole defined therethrough and the loop extending through the hole of each ring so that the inner periphery of each ring is in contact with the loop so as to shake or vibrate the loop and therefore exercises the hand holding the loop, as described in Page 3, lines 1-3.

Claim 1 stands rejected under 35 U.S.C 102(b) as allegedly anticipated by Fasano (U.S. Pat. No. 3,086,315). Claim 1 has been amended to require that the hole in each ring has a diameter generally equal to 1.5 times of an outer diameter of the loop. The specification, on page 3, lines 1-3, discloses that the inner periphery of each ring is in contact with the loop so as to shake or vibrate the loop and therefore exercises the hand holding the loop. In addition, Figures 1 and 6 show each ring having a certain height and a certain thickness such that the ring is used as a counterweight for promoting the exercising effect.

Fasano does not teach or suggest the amended claim 1. Fasano is directed to a toy that comprises of a plurality of hoops which differ in size and which may be combined in different groupings for twirling by hand or on the end of a stick, column 1, lines 11-14. As shown in the Figs. disclosed by Fasano, all the rings have a small diameter such that the rings of Fasano can not be used as a counterweight for achieving a purpose of exercise. Fasano does not teach or suggest an inner diameter of the hole in each ring being 1.5 times of an outer diameter of the loop. Indeed, being directed to hoops for used as a toy, Fasano contains absolutely no teaching or suggestion concerning a hand exerciser. Lacking such a teaching or suggestion, a determination of anticipation is improper.

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After the amendment to the claim, the rejections under 35 U.S.C. 102(b) claim 1 is overcome. Applicant respectfully submits that the amended claim 1 and the claims which depend therefrom are in a condition for allowance.

Likewise, claim 3 has been amended and claim 6 has been added to define that the holes of the rings are eccentrically defined relative to the outer periphery of the rings. Fasano contains absolutely no teaching or suggestion concerning an eccentrically defined hole.

Additionally, claims 4, 5, 7 and 8 define a polygonal outer periphery which the Examiner apparently concedes is not taught or suggested by Fasano.

Recognizing that Fasano does not teach or suggest the recitations of claims 2-4 as originally filed, the Examiner attempts to dismiss the admitted deficiencies. Initially, these deficiencies are dismissed as they "are considered matters of simple design choice obvious to one skilled in the art". It is respectfully submitted that this is not a proper ground of rejection. Specifically, as stated by the Patent Office Board of Appeals in *Ex parte Dere*, 118 U.S.P.Q. 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as *In re Newell*, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the

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citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

It is respectfully submitted that the prior art does not in any way support that applicant's hand exerciser is within the level of ordinary skill in the art. The only suggestion of the recited construction and arrangement is the hindsight knowledge of the present invention. The Examiner has not provided any prior art evidence supporting his contention, with such evidence being indicated by the Court of Appeals for the Federal Circuit as being needed to support the present rejection. It is then respectfully submitted that the Examiner must present prior art evidence showing that the modifications that the Examiner apparently concedes are not suggested by the reference applied in this official action would be a "choice" to a person skilled in the art.

It is then respectfully submitted that the rejection of claims 2-4 as originally filed has been overcome. Favorable reconsideration is respectfully requested.

Contrary to the Examiner's contention that the specific dimension or shape serves no specific purpose or provides no inherent advantage, attention is directed to specification of the present application where it is specifically disclosed that such feature result in forces that hit the loop so as to shake or vibrate the loop and therefore exercising the hand holding the loop. How could Fasano perform in this manner? Additionally, it is respectfully submitted that the absence of "unexpected or undesired results" is not a proper test for obviousness. Specifically, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 USPQ 763, 771 (1984) quoted:

A patentable invention \*\*\* may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

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Furthermore, in this case, there is an absence of any art that shows such features are old in the art. In this regard, if "notoriously old and well known in the art", why has the Examiner failed to cite a single reference suggesting such feature is old and more importantly which would suggest such feature could be utilized in the structure of Fasano. It is respectfully submitted that the rejections of claims 2-4 as originally filed under 35 U.S.C. § 103 has been overcome for each of these separate and independent reasons.

The Examiner has cited the United States patent listed in NOTICE OF REFERENCES CITED as A. By the lack of application of this reference and others like it within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's hand exercisers which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 1 and 3-8, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

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By

  
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